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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/029,379	12/20/2001	Lee E. Cannon	4875US (01-01-064-02)	3590
4743	7590	10/18/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			SAGER, MARK ALAN	
6300 SEARS TOWER			ART UNIT	PAPER NUMBER
233 S. WACKER DRIVE			3714	
CHICAGO, IL 60606			DATE MAILED: 10/18/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/029,379

Applicant(s)

CANNON ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13,20,22-37,41,43-48 and 50-59 is/are rejected.
- 7) ☒ Claim(s) 3,4,14-19,21,38-40,42 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/18/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Information Disclosure Statement***

The information disclosure statement filed Jun 18, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, FR 1474617 is neither a reference in English nor any concise explanation of its relevance provided. Jewel in the Crown brochure only considered to extent of legible content. Also, several references are duplicates of those earlier considered or cited on disclosure provided 12/20/01.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1, 5-13, 22-30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *Warmerdam*, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a "useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful

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process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. It is germane that a claim that requires one or more acts to be performed defines a process, which is one of the technological arts. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) (“A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.”). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) (“unpatentability of the principle does not defeat patentability of its practical applications”) (citing *O ’Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates

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concepts or converts one set of numbers into another.

In this instance, claimed invention for cited claims fails to define statutory subject matter in the technological arts due to the act or series of acts not changing a state or not performing a transformation. Specifically, the claimed 'providing... opportunity to qualify...' fails to cause a change in state since an opportunity does not change state and 'each player competing in the bonus game... game field' is a recitation describing manner of bonus game (field or environment of use) but neither positively recites an act or series of acts to be done that change state. As comparison only, invention, defined by claim 31 or 60, claims steps which defines statutory subject matter at least due to a change in state being positively claimed; thus, it is noted that the disclosure describes statutory subject matter; however cited claims are deemed non-statutory for not falling within the technological arts. This holding is maintained herein from prior action and reiterated above. Response to applicant's assertion of patentability is provided below and incorporated herein.

### ***Double Patenting***

3. Applicant is advised that should claim 5 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Scope of claim 6 is entirely encompassed by scope of claim 5 and each depends from independent claim 1, thus scope of claim 6 is a substantial duplicate of claim 5 for achieving a specific outcome during play of the base game.

***Allowable Subject Matter***

4. The indicated allowability of claim 31-32, 35-37, 41, 43-48, 50-59 is withdrawn in view of the newly discovered reference(s) to Luciano, Seelig, Weiss. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1-2, 6-7, 9-12, 26-33, 35-37, 41, 43-44, 50-52, 54-56, 59 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Luciano (6050895).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claim 5, 34 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Luciano ('895). Luciano discloses a hybrid gaming apparatus and method teaching claimed steps/features as broadly claimed including 'achieving at least one specific outcome during play of the base game' (11:57-12:8, 12:27-57), but does not specifically discuss alternative trigger events to a win or loss outcome as qualifying event. However, by Official Notice, such triggering events as duration or time of play, amount wagered over time, accumulation of outcomes or playing a game a number of times are notoriously well known triggering events for accessing or qualifying to play a bonus game such as being based on play or player history (as evidence only of such trigger events being notoriously well known: Acres, '284; Piechowiak, '982; Fier, '542). Thus, it would have been obvious to an artisan at a time prior to the invention to add duration or time of play, amount wagered over time, accumulation of outcomes or playing a game a number of times, as claimed, as notoriously well known to Luciano's apparatus or method for triggering bonus play based on play or player history, e.g. player tracking for bonusing. Further, alternatively, claimed triggering events are non-critical over Luciano's event of a specific game outcome to qualify for play of bonus game in that the manner or form of triggering to qualify for bonus or secondary game is not patentably distinguish over that taught by Luciano. Applicant's disclosure/claims (or evidence cited above) is evidence of their non-criticality in that some method triggers, such as method taught by Luciano, a player as being qualified to play a bonus or secondary game.

10. Claim 58 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Luciano ('895). Luciano discloses

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claimed features (sic) including a computer (3:13-15, 4:50-54) that is interpreted as being a personal computer or equivalent thereto. Alternatively, Luciano discloses a computer, micro-controller or similar programmed device for controlling the electronic terminal.

Use of a personal computer, PDA or wireless terminal by Official Notice is notoriously well known for use in electronic gaming terminal due to their relatively low cost to processing or computing power and ease of use. Art of record is evidence of PC, PDA or wireless terminal in use as electronic gaming terminal. Thus, it would have been obvious to an artisan at a time prior to invention to add PC, PDA or wireless terminal as notoriously well known to Luciano's apparatus or method for their relatively low cost to computing power and ease of their use.

11. Claim 20, 43, 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano ('895). Luciano discloses claimed features except 'hazard marker... game' (clm 20, 43) and 'other than casinos' (clm 57). Regarding 20, 43, by Official Notice, hazards in racing games is notoriously well known. Hazards are included in racing games to provide variety and to impede a user's progress in game. Hazards including other vehicles (moving or stationary), pedestrians including animals, detours or road blocks, oil slick either from a damaged vehicle or from another vehicle leaking/spraying on roadway in order to be an obstacle as an element of skill so that a player must react to avoid hazard or to generally slow or impede or obstruct a players progress in game. Therefore, it would have been obvious to an artisan at a time prior to the invention to add 'hazard marker... game' as notoriously well known to Luciano's apparatus or method to obstruct a players progress in game or to further test players skill/coordination. Regarding claim 57, by Official Notice, it is notoriously well known for users to access wagering games



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remote or from locations other than casinos such as by connecting to web sites to play wagering games or games of chance via a PC, PDA or wireless terminal from home, office or hotel/motel rooms or conveyance like airliner/cruise ship or anywhere such devices may access a internet web site using connectivity of their computing device so that user does not need to visit or travel to a casino thereby increasing accessibility to the gambling venue. Thus it would have been obvious to an artisan at a time prior to the invention to add other than casinos to Luciano's apparatus or method to increase accessibility that results in increased revenue therefrom.

12. Claim 13, 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano ('895) in view of Nakagawa (6019369) or Adams. Luciano discloses apparatus or method teaching claimed features and steps except 'physical'. However, a physical or mechanical embodiment of game play is common. Nakagawa or Adams each disclose wagering games that incorporate a physical or mechanical embodiment of game play. Some players prefer a mechanical or physical embodiment to electronic or video version since it appears more life-like or real to them and they 'trust' the physical form over the electronic form. Therefore, it would have been obvious to an artisan at a time prior to the invention to add physical as known, as taught by either Nakagawa or Adams to Luciano's apparatus or method to provide a more realistic form of game play that appeals to players.

13. Claim 1-2, 5-6, 11-13, 22-37, 45-48, 53-59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig (5664998) in view of either Seelig (5560603) or Weiss (5772509) or Luciano (6050895). Seelig discloses a combined slot machine and racing game (3:16-5:37) teaching claimed steps/features including providing a bonus game that is electronically or physically implemented having either a maze or open space and

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players competing in a network of gaming machines (fig. 1, 3) playing a bonus game by navigating a player marker (62) to a finish line based in part on strategy such as number of coins wagered (3:53-4:6, fig 1-3). Seelig lacks disclosing each player to 'qualify' for player (clm 1, 30, 32, 5-6, 34), mutually remote sites (clm 56), 'other than casinos' (clm 57) and 'personal computers... terminals' (clm 58). Regarding qualify, Seelig ('603) or Weiss or Luciano each teach providing a player is provided an opportunity to qualify in order to play the bonus game so that an automated triggering event is programmed to start the bonus game so as to eliminate manpower to oversee the start of bonus play. Therefore, it would have been obvious to an artisan at a time prior to the invention to add qualify as claimed, as taught by either Seelig ('603) or Weiss or Luciano to Seelig's '998) slot machine in order to automate bonus play thereby reducing manpower for oversight. Lack of criticality of various claimed process to qualify is reiterated herein such that claimed process to qualify is non-critical or does not patentably distinguish over process to qualify for bonus play taught with respect to Seelig ('603) or Weiss or Luciano.

Regarding claim 58, Seelig ('998) states machine is generally conventional construction and thus is deemed to include a personal computer (3:16-52) or is deemed equivalent to structure/functionality of claimed 'personal computers... terminals' in that the processing device conventionally therein performs same function of controlling game play.

Regarding claim 56-57, progressive bonus games that accumulate a plurality of mutually remote sites by Official Notice is notoriously well known in order to increase participation from increase size of jackpot awards. Further, it is reiterated herein, by Official Notice, it is notoriously well known for users to access wagering games remote

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or from locations other than casinos such as by connecting to web sites to play wagering games or games of chance via a PC, PDA or wireless terminal from home, office or hotel/motel rooms or conveyance like airliner/cruise ship or anywhere such devices may access a internet web site using connectivity of their computing device so that user does not need to visit or travel to a casino thereby increasing accessibility to the gambling venue. Thus it would have been obvious to an artisan at a time prior to the invention to add other than casinos and mutually remote sites as notoriously well known to Seelig's slot machine in view of either Seelig ('603) or Weiss or Luciano to increase accessibility that results in increased revenue therefrom or to increase participation and increase size of jackpot awards that increases excitement to play.

***Response to Arguments***

14. Applicant's arguments with respect to claim 1-2, 5-7, 9-13, 22-37, 41, 43-48, 50-59 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed 6/18/04 have been fully considered but they are not persuasive. Holding is maintained that invention as claimed is non-statutory at least due to process not causing a change in state, no act is performed as required. Applicant fails to address the fact that no change in state is performed by claimed invention when a process is claimed (that may or may not be conducted by a computer). The overriding concern is that the process fails to cause a change in state while a secondary consideration is a computer related process that also does not cause a change in state. Applicant focuses on computer related process and failed to address the overriding issue. The claim language of 'providing... one opportunity to qualify ' fails to cause a change in state since an opportunity does not change state and 'each player competing in the

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bonus game... game field' is a recitation describing manner of bonus game (field or environment of use) but neither positively recites an act or series of acts to be done that change state. A method or process requires a change in state.

Regarding claim 6, Applicant is correct in stating that the claims at issue are in a single patent application; however, due to the scope of claim 6 being completely encompassed by scope of claim 5, the warning is maintained such that if claim 5 were to be deemed patentable (presently it is not), an objection under 37 CFR 1.75 to claim 6 would be provided. Examiner agrees that an applicant may claim an invention in manner applicant chooses however, duplication is not permitted and thus the warning is provided. Examiner acknowledges Applicants stated admission that claim 6 is a subset of claim 5. It is noted that merely changing claim 6 to depend from another claim (such as claim 2) may render warning moot since scope of 6 then could not be encompassed by claim 5.

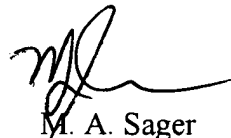
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager  
Primary Examiner  
Art Unit 3714

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